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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,420	02/11/2004	Elvin R. Lukenbach	JBP0508 DIV	2879

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EXAMINER
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HARDEE, JOHN R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/776,420

Applicant(s)

LUKENBACH ET AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.  
4a) Of the above claim(s) 9, 10, 13-21 and 31-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12, 22-30 and 45-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-30 and 45-49, drawn to a foaming composition, classified in class 510, various subclasses, depending on the specific ingredients.

If Group I is elected, further restriction will be required.

II. Claims 31-35, drawn to a method of making an oil-in-water emulsion, classified in class 252, subclass 189+.

III. Claims 36-40, drawn to a method of making an oil-in-water emulsion, classified in class 252, subclass 189+.

IV. Claims 41-43, drawn to a method of depositing a benefit agent, classified in class 510, subclass 130+.

V. Claim 44, drawn to a method of depositing a benefit agent, classified in class 510, subclass 510.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, inasmuch as II and III recite mutually exclusive steps; IV and V recite different ingredients; II and III

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are drawn to making emulsions, while IV and V are drawn to application of compositions; and I does not require the ingredients recited in methods II-V.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Having chosen one of groups I-V, applicant is further restricted to one of the following groups:

- a. An ester as recited in part a) of claim 7.
- b. An ester as recited in part b) of claim 7.
- c. An ester as recited in part c) of claim 7.
- d. An ester as recited in part d) of claim 7.
- e. An ester as recited in part e) of claim 7.
- f. An ester as recited in part f) of claim 7.
- g. An ester as recited in part g) of claim 7.
- h. An ester other than those listed above. If this group is elected, a specific ester must be named. Further restriction may be required.

5. This restriction requirement is made because the groups of esters listed above have separate status in the chemical art and are patentably distinct. A disclosure of one of these groups would not anticipate or make obvious any of the other groups.

6. Claims 1-30 and 45-49 are generic to a plurality of disclosed patentably distinct species comprising esters. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of ester, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. During a telephone conversation with Ms. Erin Harriman on June 29, 2004 a provisional election was made with traverse to prosecute the invention of Group Ib and the species pentaerythritol tetraoctanoate, claims 1-8, 11, 12, 22-30 and 45-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9, 10, 13-21 and 31-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 9, 10, 13-21 and 31-43 are withdrawn from consideration as being drawn to non-elected inventions. The remaining claims were searched and examined only to the extent that they read on the elected invention.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 47 and 48 provide for the use of a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 47 and 48 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 48 is additionally indefinite because it is a composition claim which depends from what appears to be a method claim.

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11. Claims 1-3, 6-8, 11, 12, 22-30 and 46-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the water dispersible components recited in claim 4, does not reasonably provide enablement for any and all conceivable water dispersible components. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The examiner suggests that the limitations of claim 4 be incorporated into claim 1 to overcome this rejection.

12. Claims 1-8, 22-30 and 46-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the esters recited in claim 11, does not reasonably provide enablement for any and all conceivable esters as recited in part b of claim 7. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or practice the invention commensurate in scope with these claims. The examiner recommends that the limitations of claim 11 be incorporated into claim 1 to overcome this rejection.

### ***Double Patenting***

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-8, 11, 12, 22-30 and 45-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 23-30 of copending Application No. 09/604,449. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '449 application claims essentially the same compositions, except that the dispersible component is hexylene glycol and the compositions contain silicone. Accordingly, these claims anticipate the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.



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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 1, 2, 4-8, 11, 12, 22-27, 29, 30, 44, and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al., US 4,980,155. The reference discloses two-phase cosmetic compositions comprising a color phase and a gel phase. An essential component of the color phase is a film forming agent at 1-30% of the composition. Preferred film forming agents include pentaerythritol tetraoctanoate (col. 3, lines 25-43). Another essential component of the color phase is an emulsifier. A particularly preferred emulsifier is a blend of triethanolamine and stearic acid (col. 3, lines 44-53). The emulsifier is present at 1-10% by weight of the color forming composition. The examiner notes that when these ingredients are blended in the presence of water, the product is triethanolammonium stearate, which is a soap and a foaming anionic surfactant. Another essential component is water at about 10-98% of

the compositions (col. 3, lines 61-62). The compositions may include humectants at 10-30% of the composition. Hexylene glycol is a preferred humectant (col. 5, lines 20-22). Additional optional components include polyethylene glycol stearates (col. 6, lines 9-10). The examiner takes the position that this bears a genus-species relationship with polyethylene glycol-30 dipolyhydroxystearate, as recited in claim 23. Addition of carbomers, a family of polyacrylate homopolymers and copolymers, is disclosed at col. 5, lines 62+. Addition of hydrolyzed silk is disclosed at col. 7, lines 48-49. Method claim 44 is drawn to the intended use of a cosmetic composition and is obvious in view of the disclosure. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a cosmetic composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone

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number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Hardee', with a stylized, cursive script.

John R. Hardee  
Primary Examiner  
July 14, 2004